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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,519	11/09/2000	Satoru Nippa	2185-480P	1737

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/708,519

Applicant(s) *8m 11*

NIPPA, SATORU

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-2.Claim(s) withdrawn from consideration: 3-4.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Attachment to Advisory Action

1. Applicant's arguments and 1.132 declaration filed 4/15/03 have been fully considered but they are not persuasive.

Specifically, applicant argues, as well as provides a 1.132 declaration to support the argument, that, contrary to examiner's position, the method of Yamada et al. (U.S. 4,491,553), i.e. mixing in a kneader a resin in particulate form with filler and fibrillatable polytetrafluoroethylene (PTFE) cannot produce resin composite with Y/X index as presently claimed. In the declaration, a resin composite is made using method of Yamada et al., i.e. mixing in a kneader styrene-butadiene rubber, aluminum hydroxide (AlOH) with average particle diameter of 13 nm, and fibrillatable PTFE. The resin composite formed from such method possesses Y/X index outside the scope of the present claims.

However, it is the examiner's position that applicant's arguments and declaration are not persuasive for the following reasons.

In the declaration, applicant produces resin composite by mixing in a kneader styrene-butadiene rubber, AlOH, and fibrillatable PTFE, which appears to follow the method of example 2 in Yamada et al. However, there appears to be another method disclosed by Yamada et al. Col.5, lines 59-61 and 65-68 of Yamada et al. disclose that the particulate resin and the filler (AlOH), are mixed in the presence of fibrillatable PTFE whereby the resin and filler agglomerate, i.e. aggregate. The agglomerate then forms a resin composite upon further mixing. Further, col.4, lines 58-49 disclose that in one embodiment the PTFE is used in the form of an aqueous emulsion. Additionally, in other examples of Yamada et al. such as examples 3-5, kneading is not required, i.e. "non-kneaded". Thus, given that Yamada et al. disclose mixing

aqueous resin emulsion with ALOH to form agglomerate or aggregate which then forms resin composite, which is similar to the method used in the present invention given that no kneading is utilized and the resin composite is formed from agglomeration of resin and ALOH, it follows that such resin composite would also inherently possess Y/X index as presently claimed.

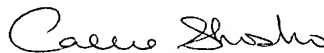
While the declaration discloses that the resin composite of Yamada et al. possesses Y/X index outside the scope of the present claims, this is based on one preferred embodiment of Yamada et al. as set forth in example 2. Other embodiments of Yamada et al. produce the resin composite by different method as described above including embodiment where PTFE is in the form of an aqueous emulsion. Given that the declaration does not address this other embodiment of Yamada et al. which does not use kneading but rather agglomerates the resin and filler to form resin composite, it is not clear, i.e. no evidence has been provided, that resin composite produced by this other method will also possess Y/X index outside the scope of the present claims. Thus, given that Yamada et al. disclose resin composite comprising resin and aluminum hydroxide wherein the dispersion of the filler in the resin is very uniform, it is the examiner's position that, absent evidence to the contrary, Yamada et al. meets the limitations of the present resin composite claims.

While it is noted that Yamada et al. requires the use of both thermoplastic resin and PTFE, in light of the open language of the present claims, i.e. "comprising", it is clear that the present claims are open to the inclusion of additional ingredients including fibrillatable PTFE as disclosed by Yamada et al. Further, as shown in the Table of applicant's declaration, the use of PTFE does not significantly affect the degree of dispersion of the resin composite.

While page 6, lines 11-22 of the present specification and the declaration show that kneading particulate resin and AIOH does not result in resin composite possessing Y/X index as presently claimed, Yamada et al. also disclose a method wherein kneading is not required but where the resin composite forms by agglomeration.

Further, it is noted that the declaration utilizes PTFE known under the tradename F-104, which is different than any of the PTFE utilized in Yamada et al. (see col.5, lines 25-34). Thus, it is not clear if the PTFE utilized in the declaration is the same as that utilized in Yamada et al. and if the PTFE are different, what effect, if any, the difference would have on the Y/X index of the resin composite.

Thus, given that Yamada et al. disclose mixing aqueous PTFE emulsion, resin, and AIOH to produce resin composite by agglomeration or aggregation of the resin and AIOH, it is the examiner's position that such resin composite, absent evidence to the contrary, would inherently possess Y/X index as presently claimed.



Callie E. Shosho
Examiner
Art Unit 1714

CS
April 30, 2003